

REMARKS

Claims 1-3, 5-18 and 21-24 are pending in this application. Claims 17, 18, 21-26 and 29-32 have been withdrawn due to an Election of Species Requirement. Claims 17, 18 and 21-24 should be rejoined and allowed when claim 1 is allowed. By this Amendment, independent claim 1 is amended to incorporate the features of claim 4, claims 2, 3, 5-18 and 21-24 are amended to correct informalities, and claims 4, 25, 26 and 29-32 are canceled without prejudice to, or disclaimer of, the subject matter recited therein. Applicants reserve the right to file one or more divisional applications to pursue the subject matter of canceled claims 25, 26 and 29-32. No new matter is added. Reconsideration of this application in view of the above amendments and the following remarks is respectfully requested.

The Office Action objects to the specification due to a typographical error. The informalities in the specification, for example on page 17, line 1, appear only in the scanned version of the specification created by the Patent Office. These informalities do not appear in the specification as it was originally filed. However, to address the errors caused by the PTO's scanning of the facsimile copy of the application as filed, a substitute specification that contains text corresponding to the specification as originally filed is attached. The substitute specification contains no mark-ups because no changes were made. As such, no new matter is added. Thus, it is respectfully requested that the objection be withdrawn.

The Office Action objects to claims 1, 3-5, 8-10 and 12 under 35 U.S.C. §112, second paragraph, due to informalities. The objections are obviated by the above amendments. Thus, it is respectfully requested that the objections be withdrawn.

The Office Action rejects claims 1-3 and 13 under 35 U.S.C. §102(e) or §103(a) over Tamura et al. (Tamura), U.S. Patent No. 6,558,637. The rejection is respectfully traversed.

Tamura does not disclose, and would not have rendered obvious, an exhaust gas purifying apparatus having electrodes that comprise an electric-discharge electrode that

extends upstream of an upstream end of a honeycomb structure, as recited in independent claim 1.

As mentioned above, independent claim 1 is amended to incorporate features similar to those recited in canceled claim 4. The Office Action does not reject claim 4 over Tamura. Therefore, independent claim 1 and dependent claims 2, 3 and 13 are patentable over Tamura. Thus, it is respectfully requested that the rejection be withdrawn.

The Office Action rejects claims 4-12 and 14-16 under 35 U.S.C. §103(a) over Tamura in view of Palekar et al. (Palekar), U.S. Patent No. 6,475,350. The rejection of canceled claim 4 is moot. The rejection of claims 5-12 and 14-16 is respectfully traversed.

Because claims 5-12 and 14-16 incorporate the features of independent claim 1, and because Palekar fails to overcome the deficiencies of Tamura, these claims also are patentable over the applied references for at least these reasons, as well as for the additional features that these claims recite. Thus, it is respectfully requested that the rejection be withdrawn.

Further, amended independent claim 1 is patentable over the combination of Tamura and Palekar. Specifically, the combination of Tamura and Palekar does not disclose, and would not have rendered obvious, an exhaust gas purifying apparatus having electrodes that comprise an electric-discharge electrode that extends upstream of an upstream end of a honeycomb structure, as now recited in independent claim 1.

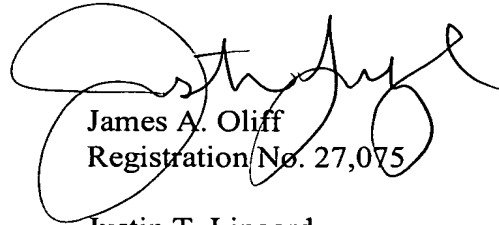
As discussed above, Tamura does not disclose the features of independent claim 1. Palekar fails to overcome the deficiencies of Tamura. Palekar discloses an electrode 4a that is disposed at an upstream end of catalyst bed 2 (see Fig. 1A). However, the electrode 4a does not extend upstream of the upstream end of the catalyst bed 2. Although the Office Action asserts that it would have been obvious to one of ordinary skill in the art to modify Tamura with the teachings of Palekar to select the claimed electrode configurations, there is no evidence to support the Office Action's conclusion. Specifically, The Office Action

merely states that the combination would have been obvious because "selection of any of electrode [sic] known electrode configurations and catalyst material would have been within the level of ordinary skill in the art." This reasoning is insufficient to support an obviousness rejection in view of the Patent Office's Examination Guidelines for Determining Obviousness Under 35 U.S.C. § 103(a) in view of *KSR International Co. v. Teleflex Inc.* The Guidelines state that the Examiner should clearly articulate why the claimed invention would have been obvious. For example, the Supreme Court in *KSR* held that the Examiner "must [provide] some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness" (*KSR*, 82 USPQ2d 1385, 1396 (2007)). Moreover, the claimed arrangement is not "known" from Tamura or Palekar because neither references disclose the claimed location of the electric-discharge electrode. Therefore, the combination of Tamura and Palekar does not disclose, and would not have rendered obvious, an exhaust gas purifying apparatus having electrodes that comprise an electric-discharge electrode that extends upstream of an upstream end of a honeycomb structure, as now recited in independent claim 1. Therefore, independent claim 1 is patentable over the combination of Tamura and Palekar.

In view of the foregoing, it is respectfully submitted that this application is in condition for allowance. Favorable reconsideration and prompt allowance are earnestly solicited.

Should the Examiner believe that anything further would be desirable in order to place this application in even better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number set forth below.

Respectfully submitted,



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Attachments:

Petition for Extension of Time
Substitute Specification

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